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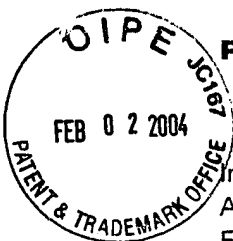
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PATENT

AF 3644

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Jeffrey Lynn Chamberlain

Application No.: 09 / 922,376 Group No.: 3644

Filed: 08/03/2001

Examiner: Smith, Kimberly

For: Dog Watering Toy

Mail Stop Appeal Briefs - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION—37 C.F.R. § 1.192)**

NOTE: The phrase "the date on which" an "appeal was taken" in 35 U.S.C. 154(b)(1)(A)(ii) (which provides an adjustment of patent term if there is a delay on the part of the Office to respond within 4 months after an "appeal was taken") means the date on which an appeal brief under § 1.192 (and not a notice of appeal) was filed. Compliance with § 1.192 requires that: 1. the appeal brief fee (§ 1.17(c)) be paid (§ 1.192(a)); and 2. the appeal brief complies with § 1.192(c)(1) through (c)(9). See Notice of September 18, 2000, 65 Fed. Reg. 56366, 56385-56387 (Comment 38).

1. Transmitted herewith, in triplicate, is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on Nov. 27, 2003.

NOTE: "Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate. . . ." 37 C.F.R. § 1.192(a) (emphasis added).

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

(When using Express Mail, the Express Mail label number is mandatory;
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

☒ deposited with the United States Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

37 C.F.R. § 1.8(a)

37 C.F.R. § 1.10 *

☒ with sufficient postage as first class mail.

☐ as "Express Mail Post Office to Addressee"

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TRANSMISSION

☐ facsimile transmitted to the Patent and Trademark Office. (703) _____

Date: 1/26/04

Signature

Charles R. Sutton

(type or print name of person certifying)

* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

2. STATUS OF APPLICANT

This application is on behalf of

☐ other than a small entity.

☒ a small entity.

A statement:

☐ is attached.

☒ was already filed.

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. § 1.17(c), the fee for filing the Appeal Brief is:

☒ small entity \$165.00 ~~\$160.00~~

☐ other than a small entity \$320.00

Appeal Brief fee due \$ 165.00

4. EXTENSION OF TERM

NOTE: 37 C.F.R. § 1.704(b) " . . . an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph."

NOTE: The time periods set forth in 37 C.F.R. § 1.192(a) are subject to the provision of § 1.136 for patent applications. 37 C.F.R. § 1.191(d). See also Notice of November 5, 1985 (1060 O.G. 27).

NOTE: As the two-month period set in § 1.192(a) for filing an appeal brief is not subject to the six-month maximum period specified in 35 U.S.C. § 133, the period for filing an appeal brief may be extended up to seven months. 62 Fed. Reg. 53,131, at 53,156; 1203 O.G. 63, at 84 (Oct. 10, 1997).

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

(complete (a) or (b), as applicable)

- (a) ☐ Applicant petitions for an extension of time under 37 C.F.R. § 1.136 (fees: 37 C.F.R. § 1.17(a)(1)-(5)) for the total number of months checked below:

| Extension (months) | Fee for other than small entity | Fee for small entity |
|---------------------------------------|------------------------------------|-------------------------|
| <input type="checkbox"/> one month | \$ 110.00 | \$ 55.00 |
| <input type="checkbox"/> two months | \$ 410.00 | \$ 205.00 |
| <input type="checkbox"/> three months | \$ 930.00 | \$ 465.00 |
| <input type="checkbox"/> four months | \$ 1,450.00 | \$ 725.00 |
| <input type="checkbox"/> five months | \$ 1,970.00 | \$ 985.00 |

Fee: \$ _____

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

- ☐ An extension for _____ months has already been secured, and the fee paid therefor of \$ _____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ _____

or

- (b) ☒ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE

The total fee due is:

Appeal brief fee \$ 165.00

Extension fee (if any) \$ 0

TOTAL FEE DUE \$ 165.00

6. FEE PAYMENT

☒ Attached is a ☒ check ☐ money order in the amount of \$ 165.00

☐ Authorization is hereby made to charge the amount of \$ _____

☐ to Deposit Account No. _____

☐ to Credit card as shown on the attached credit card information authorization form PTO-2038.

WARNING: Credit card information should *not* be included on this form as it may become public.

- ☐ Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

A duplicate of this paper is attached.

7. FEE DEFICIENCY

NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to change the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.

- ☐ If any additional extension and/or fee is required,

AND/OR

- ☐ If any additional fee for claims is required, charge:

☐ Deposit Account No. _____

☐ Credit card as shown on the attached credit card information authorization form PTO-2038.

WARNING: Credit card information should *not* be included on this form as it may become public.

Date: Jan. 25, 2004

Reg. No.: 42,176

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27615

PATENT TRADEMARK OFFICE

Charles R Sutton

SIGNATURE OF PRACTITIONER

Charles R. Sutton

(type or print name of practitioner)

14507 SylvanST., Ste. 208

P.O. Address

Van Nuys, CA 91411

(818) 780-6616

(Transmittal of Appeal Brief [9-6.1]—page 4 of 4)

(Text continued on page 9-55)



Practitioner's Dock # N . 75

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Jeffrey Lynn Chamberlain
Application No.: 09/922,376 Group No.: 3644
Filed: 08/03/2001 Examiner: Smith, Kimberly
For: Dog Watering Toy

Assistant Commissioner for Patents
Washington, D.C. 20231

ATTENTION: Board of Patent Appeals and Interferences

APPELLANT'S BRIEF (37 C.F.R. § 1.192)

This brief is in furtherance of the Notice of Appeal, filed in this case on
Nov. 27, 2003

The fees required under § 1.17, and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate. (37 C.F.R. § 1.192(a))

NOTE: Appellant's brief is required by 37 C.F.R. § 1.192(c) to contain the following items, under appropriate headings, in the following order:

- (1) identification of the real party in interest;
- (2) identification of related appeals and interferences;
- (3) status of all the claims, pending or canceled, and identifying the claims appealed;
- (4) status of any amendment filed subsequent to final rejection;
- (5) summary of the invention;
- (6) concise statement of the issues presented for review;
- (7) statement that the claims of a group do not stand or fall together as to each ground of rejection that applies to two or more claims;
- (8) arguments of the appellant, with each issue in separate headings, with respect to each issue presented for review; and
- (9) an appendix containing a copy of the claims involved in the appeal.

The rule further sets out specific requirements for arguments against rejections based on 35 U.S.C. §§ 102, 103, 112 and other grounds. The examiner's answer to the brief will follow a corresponding format.

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. § 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

☒ deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Commissioner for Patents
P.O. Box 1450, Alexandria,
Date: 1/26/04 VA22313-1450

FACSIMILE

☐ transmitted by facsimile to the Patent and Trademark Office.

Signature

Charles R. Sutton

(type or print name of person certifying)

Pursuant to 37 C.F.R. § 1.192(d), if a brief is filed that does not comply with the new requirements, as set forth in paragraph (c) of the rule, the appellant will be notified of the reasons for noncompliance and provided with a period of one month within which to file an amended brief. The one-month period will not be extended. If appellant does not file a brief overcoming the reasons for noncompliance within the one-month period, or files an amended brief that does not overcome all the reasons for noncompliance stated in the notification, the appeal will be dismissed.

If appellant disagrees with the examiner's holding of noncompliance, a petition under 37 C.F.R. § 1.181 may be filed. Notice of May 3, 1988 (1092 O.G. 26-35).

NOTE: 37 C.F.R. § 1.192(c) merely specifies the minimum requirements for a brief, and does not prohibit the inclusion of any other material which an appellant may consider necessary or desirable, for example, a list of references, table of contents, table of cases, etc. A brief is in complete compliance with 37 C.F.R. § 1.192(c) as long as it includes items (1) to (9) in the order set forth (with the appendix, item (9), at the end). See also Notice of March 3, 1995, 60 Fed. Reg. 14,488-14,536, at 14,500 and M.P.E.P. § 1206, 7th. ed.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 1.192(c)):

- I REAL PARTY INTEREST
- II RELATED APPEALS AND INTERFERENCES
- III STATUS OF CLAIMS
- IV STATUS OF AMENDMENTS
- V SUMMARY OF INVENTION
- VI ISSUES
- VII GROUPING OF CLAIMS
- VIII ARGUMENTS

(check each category of ARGUMENT submitted in this brief)

- ☐ ARGUMENT: VIIIA REJECTIONS UNDER 35 U.S.C. 112, FIRST PARAGRAPH
- ☐ ARGUMENT: VIIIB REJECTIONS UNDER 35 U.S.C. 112, SECOND PARAGRAPH
- ☒ ARGUMENT: VIIC REJECTIONS UNDER 35 U.S.C. 102
- ☒ ARGUMENT: VIID REJECTIONS UNDER 35 U.S.C. 103
- ☐ ARGUMENT: VIIIE REJECTIONS OTHER THAN 35 U.S.C. 102, 103 AND 112

IX APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

- ☒ OTHER MATERIALS THAT APPELLANT CONSIDERS NECESSARY OR DESIRABLE *not included.*

The final page of this brief bears the practitioner's signature.

WARNING: "Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown." 37 C.F.R. § 1.192(a).

The Board has leeway to consider arguments or authorities not included in the brief under circumstances where the failure to include them can be justified. Notice of May 3, 1988 (1092 O.G. 26-35).

I REAL PARTY IN INTEREST (37 C.F.R. § 1.192(c)(1))

NOTE: The brief shall contain "A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest." 37 C.F.R. § 1.192(c)(1). See M.P.E.P. § 1206, 7th ed.

The real party in interest in this appeal is:

- ☒ the party named in the caption of this brief.
- ☐ the following party:

II RELATED APPEALS AND INTERFERENCES

(34 C.F.R. § 1.192(c)(2))

NOTE: The brief shall contain "[a] statement identifying by number and filing date all the appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal." 37 C.F.R. § 1.192(c)(2). See M.P.E.P. § 1206, 7th ed.

(complete (A) or (B), as applicable)

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal:

A ☒ there are no such appeals or interferences.

B ☐ these are as follows:

III STATUS OF CLAIMS (37 C.F.R. § 1.192(c)(3))

NOTE: The brief shall contain: "A statement of the status of all the claims, pending or cancelled, and identifying the claims appealed." 37 C.F.R. § 1.192(c)(3).

For each claim, the appellant "should state whether it is cancelled, allowed, rejected, etc. Each claim on appeal must be identified." Notice of May 3, 1988 (1092 O.G. 26-35). See M.P.E.P. § 1206, 7th ed.

The status of the claims in this application are:

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20.

B. STATUS OF ALL THE CLAIMS

(if there are no claims in a category, indicate: NONE)

1. Claims cancelled: NONE
2. Claims withdrawn from consideration but not cancelled: 6, 9, 14-20.
3. Claims pending: 1-20.
4. Claims allowed: NONE
5. Claims rejected: 1, 2, 3, 4, 5, 7, 8, 10, 11, 12, 13.

C. CLAIMS ON APPEAL

The claims on appeal are: 1, 2, 3, 4, 5, 7, 8, 10, 11, 12, 13.

IV STATUS F AMENDMENTS (37 C.F.R. § 1.192(c)(4))

NOTE: The brief shall contain "A statement of the status of any amendment filed subsequent to final rejection." 37 C.F.R. § 1.192(c)(4). "The appellant should state, insofar as understood by the appellant, the status of any amendment filed subsequent to final rejection, i.e., whether or not the amendment has been acted upon by the examiner, and if so, whether it was entered, denied entry, or entered in part." The inclusion of the status of claims (Section I) [now Section 3] and this section will advise the examiner of what the appellant considers the status of the claims and post-final rejection amendments to be, allowing any disagreements on these questions to be resolved before the appeal is taken up for decision by the Board. Notice of May 3, 1988 (1092 O.G. 26-35). See M.P.E.P. § 1206, 7th ed.

No claims have been amended subsequent to the Final Rejection. Claims 1, 2, 4, 5, 11, were amended 08/05/03 (prior to the 08/29/03 final rejection). Claims 6, 8, 9, 14, 20 were amended 09/20/02 (also prior to the 08/29/03 final rejection).

V. SUMMARY OF INVENTION (37 C.F.R. sec. 1.192(c)(5))

The invention of claims 1-5 is an apparatus to alleviate pet thirst that comprises a reservoir having a wall (Figure 2, reference character 2). It also has a fill aperture (Figure 1, reference character 3), valves (Figure 1, reference character 5), and a closeable, openable cap (Figure 1, reference character 4)(Page 5, lines 7-13). The cap allows liquid to enter (page 5, lines 7, 8). There is an outer layer enclosing the wall which is shaped to resemble a food item (Figure 1)(Page 5, lines 17-23). The invention may come equipped with indicia on the outside (Figure 4, reference character 9). The invention may come equipped with an attached cord (Figure 3, reference character 7)(Page 7, lines 16-19). The invention may come equipped with a noisemaker inside the reservoir (Page 7, lines 20-23)(Figure 6, reference character 8).

The invention of claims 7, 8, 10-13 differs from this in that the preamble is merely "In combination:" and the outer layer shaped to resemble a food item is not necessarily present, since it does not appear in the independent claim 7, but is later disclosed in the dependent claim 11. Moreover, the valves are bores in the wall (claim 7, line 3)(Figure 7, reference character 5), and there is a valve mechanism in the bore (Figure 7, reference character 11)(Page 8, lines 2, 8-11). There is a return means urging the valve mechanism closed (Page 8, lines 8-11)(Figure 8) and the valve can be opened by pressure (Page 8, lines 1-2).

VI. ISSUES (37 C.F.R. sec. 1.192(c)(6))

1. Whether claims 1, 2, 7, 8, and 11 are unpatentable under 35 U.S.C. 102 over Deshaies, US Patent 5,944,516.

2. Whether claims 3 and 12 are unpatentable under 35 U.S.C. 103 over Deshaies, US Patent 5,944,516 in view of the examiner's contention of what is known in the art.

3. Whether claims 4 and 10 are unpatentable under 35 U.S.C. 103 over Deshaies, US Patent 5,944,516 in view of Hass, US Patent 5,961,406.

4. Whether claims 5 and 13 are unpatentable under 35 U.S.C. 103 over Deshaies, US Patent 5,944,516 in view of Huettnner et al., US Patent 6,092,489.

VII. GROUPING OF CLAIMS (37 C.F.R. sec. 1.192(c)(7))

With regard to the claims rejected under 35 U.S.C. 102, to wit claims 1, 2, 7, 8, and 11, these claims do not all stand or fall together. Claims 1 and 2 are in a different group than claims 7, 8, and 11. Please refer to the argument section below for additional details.

With regard to the claims rejected under 35 U.S.C. 103, to wit claims 3, 4, 5, 10, 12, and 13, these claims do not all stand or fall together. Claims 3 and 12 are in one group. Claims 4 and 10 are in a different group. Claims 5 and 13 are in yet a different group. Please refer to the argument section below for additional details.

VIIIC. ARGUMENTS-REJECTIONS UNDER 35 U.S.C. SEC. 102

(37 C.F.R. sec. 1.192(c)(8)(iii))

Claims 1, 2, 7, 8, and 11 do not all stand or fall together. Claim 1 is actually deleted and therefore simply needs to be cancelled. Claim 2 is an independent claim having an outer layer shaped to resemble a food item. Claim 7 is an independent claim that does not have an outer layer shaped to resemble a food item. Claim 7 has the limitation that the valves comprise bores and there is a valve mechanism in the bores which is capable of substantially perpendicular movement with respect to the wall. Claim 2 does not disclose such a valve mechanism. Claims 8 and 11 depend from claim 7 but not from claim 2. Therefore, since claim 2 contains an element not found in claims 7, 8, and 11, and since claims 7, 8, and 11 contain elements and cooperation between the elements not disclosed in claim 2, claim 2 must be considered separately from claims 7, 8, and 11.

Where all the elements (or their equivalents) of the claimed invention cannot be found in one unit of prior art, there is no anticipation (Firestone v. Aluminum Co. of America, 285 F.2d 928, 127 U.S.P.Q. 407 (1960)). For prior art to anticipate under 35 U.S.C. section 102 every element of the claimed invention must be identically disclosed, either expressly or under principles of inherency, in a single reference (Corning Glass Works v. Sumitomo Electric, 9 U.S.P.Q. 2d 1962, 1965 (Fed. Cir. 1989)).

ISSUE ONE

Claim 1 is actually subject to an objection rather than a rejection. Objections are not the proper subject matter of appeals, but instead of Petitions (Rule 181). Applicant will cancel the claim if appropriate after the termination of the appeal.

Applicant has amended the phrase in claim 2 about aesthetic design to read instead that the outer layer is shaped to resemble a food item. The "Deshaies invention" (US Patent No. 5,944,516) does not contain such a structure and therefore there can be no anticipation. Since all the elements of the claimed invention are not identically disclosed in the Deshaies Patent, there can be no anticipation under 35 U.S.C. section 102 and therefore the Examiner's rejection of claim 2 is improper. The Board is respectfully requested to overrule the rejection of claim 2 based on 35 U.S.C. section 102.

With respect to the rejection of claim 7 and claim 8, Applicant respectfully disagrees with the Examiner's position on the grounds that the two valves disclosed by the Deshaies invention do not have a structure that moves in a substantially perpendicular alternate movement with respect to the wall. The Deshaies invention discloses a check valve which moves in an arcuate manner and therefore is not susceptible to operation by the pressure of canine teeth. (see Figure 2). The Deshaies invention shows valves at Figure 7 which are slits deformable under pressure and there fore move in a direction substantially parallel with the wall. They also do not contain a valve mechanism at all other than the wall edges which comprise the slits. (See column 6, lines 33-39).

With respect to the rejection of claim 11, Applicant respectfully disagrees with the Examiner's position on the grounds that the two valves disclosed by the Deshaies invention do not have a structure that moves in a substantially perpendicular alternate movement with respect to the wall. The Deshaies invention discloses a check valve which moves in an arcuate manner and therefore is not susceptible to operation by the pressure of canine teeth. (see Figure 2). The Deshaies invention shows valves at Figure 7 which are slits deformable under pressure and there fore move in a direction substantially

parallel with the wall. They also do not contain a valve mechanism at all other than the wall edges which comprise the slits. (See column 6, lines 33-39). Applicant further disagrees with the rejection of claim 11 because claim 11 discloses an outer layer shaped to resemble a food item. The Deshaies invention does not disclose such a feature at all. Instead, its surface is covered with brushes. The features in applicant's invention are not identically disclosed in the Deshaies invention. Features are absent and other features work in the opposite way to those disclosed by applicant's invention.

Since all the elements of claims 7, 8, and 11 are not identically disclosed in Deshaies invention, there is no anticipation under 35 U.S.C. section 102 and therefore the rejections are improper. The Board is respectfully requested to overturn the Examiners rejection of claims 1, 2, 7, 8, and 11 based upon 35 U.S.C. section 102.

VIIID. ARGUMENTS-REJECTIONS UNDER 35 U.S.C. SEC. 103

(37 C.F.R. sec. 1.192(c)(8)(iv))

The obviousness rejection of claims 3 and 12 are founded on the Deshaies Patent in view of the Examiner's statement of what is known in the art. The obviousness rejections of claims 4 and 10 are founded on the Deshaies Patent in view of Hass, US Patent 5,961,406. The obviousness rejections of claims 5 and 13 are founded on the Deshaies Patent in view of Huettner et al., US Patent 6,092,489. Since different combinations are being made by the Examiner to reject these claims the claims do not all stand or fall together. Claims 3 and 12 are in one set, claims 4 and 10 are in another set, and claims 5 and 13 are in a third different set, each set of which will require a different analysis of whether the combination of references is sufficient to render the invention obvious under 35 U.S.C. section 103. The sets must be considered separately.

When the alleged prior art does not specifically address the types of problems addressed by the technology of the invention, the prior art alleged is not applicable in combinations to render the invention obvious (Caster v. U.S., 9 U.S.P.Q. 2d 1753 (Cls. Ct. 1988)). Where the prior art does not appreciate the existence of the problem solved by the invention, the applicant's recognition of the problem is, in itself, strong evidence of the non-obviousness of the invention (In Re Nomiya, et al., 184 U.S.P.Q. 607, 612-613 (C.C.P.A. 1975)).

ISSUE TWO

Applicant respectfully disagrees with the Examiner's position and insists that claim 3 shows indicia that would not be visible through the brushes covering the Deshaies

invention. See Figure 1 and Figure 5 of the Deshaies invention. The Deshaies invention has a surface almost entirely covered in brushes or valves. Since this would cover or obscure any indicia on the surface, Deshaies teaches away from the invention of Jeffrey Chamberlain making Chamberlain's invention non-obvious. Applicant respectfully disagrees with the Examiner's position with respect to claim 12 in that claim 12 shows indicia that would not be visible through the brushes covering the Deshaies invention. See Figure 1 and Figure 5 of the Deshaies invention. The Deshaies invention has a surface almost entirely covered in brushes or valves. Since this would cover or obscure any indicia on the surface, Deshaies teaches away from the invention of Jeffrey Chamberlain making Chamberlain's invention non-obvious. In fact, the Deshaies Patent does not appreciate the existence of the problem solved by the invention since it is solving another problem (brushing an animal's teeth). The brushes are where the indicia would be because of this failure to appreciate the problem. That is strong evidence of the non-obviousness of the Chamberlain claims 3 and 12 according to In Re Nomiya, et al. Supra. Moreover, the Deshaies Patent does not specifically address the problem of how to provide a metered amount of drinking water for an animal and therefore Deshaies is not applicable in combinations to render claims 3 and 12 obvious according to Caster v. U.S. Supra. Finally, indicia are not known in the art to make the device more attractive to the animals, notwithstanding the Examiners unsupported statement to the contrary. Dogs and cats cannot read, and they are colorblind. The rejection of claims 3 and 12 under 35 U.S.C. section 103 is not proper and Applicant respectfully requests the Board to overturn the Examiner's rejection of those claims on that ground.

ISSUE THREE

Applicant respectfully disagrees with the Examiner's position and insists that claim 4 discloses a feature which the Deshaies invention teaches away from, and in fact states that the feature would be harmful to pets. See Column 2, lines 3-7 where the Deshaies invention teaches that dogs could tear apart and choke on large pieces of rope. Deshaies assumes, in other words that dogs would choke on the carrying strap disclosed by the Chamberlain invention. Chamberlain's use of the carrying strap is therefore non-obvious. Applicant respectfully disagrees with the Examiner's position about claim 10, and insists that claim 10 discloses a feature which the Deshaies invention teaches away from, and in fact states that the feature would be harmful to pets. See Column 2, lines 3-7 where the Deshaies invention teaches that dogs could tear apart and choke on large pieces of rope. Deshaies assumes, in other words that dogs would choke on the carrying strap disclosed by the Chamberlain invention. Chamberlain's use of the carrying strap is therefore non-obvious. The prior art does not specifically address the types of problems addressed by claims 4 and 10 herein, and in fact specifically teaches away from that technology. Deshaies cannot be used in combinations to render claims 4 and 10 obvious because of the working of Caster v. U.S. *Supra*. The combination with Hass (US Patent 5,961,406) would be inoperative because the Hass device has a rope going through the hollow portion (see Figure 3) and therefore water would be continually soaking out through the rope itself, whether the toy was being used or not. Hass does not appreciate the existence of the problem being solved by Applicant and therefore claims 4 and 10 are non-obvious according to In Re Nomiya *Supra*. The rejection of claims 4 and 10 for obviousness due to Deshaies in view of Hass is improper and the Board is respectfully

requested to overrule the Examiner's rejection of these claims under 35 U.S.C. section 103.

ISSUE FOUR

Applicant respectfully disagrees with the Examiner's position and insists that claim 5 discloses a feature which would be completely inoperable if combined with the Deshaies invention. The hollow cavity in Deshaies is affirmatively stated to be filled with a liquid of a paste-like consistency. Such a liquid would prevent a bell from ringing or a reed from sounding and therefore the Deshaies invention teaches away from the combination made by Chamberlain in the instant invention. This claim is therefore non-obvious. Applicant respectfully disagrees with the Examiner's position and insists that claim 13 discloses a feature which would be completely inoperable if combined with the Deshaies invention. The hollow cavity in Deshaies is affirmatively stated to be filled with a liquid of a paste-like consistency. Such a liquid would prevent a bell from ringing or a reed from sounding and therefore the Deshaies invention teaches away from the combination made by Chamberlain in the instant invention. This claim is therefore non-obvious. Deshaies does not specifically address the question of noisemaking in a pet toy and is therefore not applicable to render claims 5 and 13 obvious according to Caster v. U.S. Supra. Deshaies shows that it does not even appreciate the existence of the problem being solved in claims 5 and 13 herein (because of the paste) and this is strong evidence of the non-obviousness of the invention of claims 5 and 13 according to In Re Nomiya Supra. Huettner et al. (US Patent No. 6,092,489) shows tennis balls without any valves whatsoever. There is no addressing of the problem of watering a dog and therefore this patent cannot be used in combinations to render claims 5 and 13 obvious (Caster v. U.S.

Supra). The Examiner's use of Deshaies and Huettner et al. to reject claims 5 and 13 as obvious is improper and the Board is respectfully requested to overrule the Examiners rejection of claims 5 and 13 under 35 U.S.C. section 103.

IX. APPENDIX OF CLAIMS (37 C.F.R. sec. 1.192(c)(9))

The texts of the claims involved in the appeal are:

1. (Amended)
2. (Amended) An apparatus to alleviate pet thirst comprising:
a reservoir having a wall, said wall having a fill aperture and valves; said fill aperture having a closeable openable cap, said cap when open allowing liquid to enter said reservoir through said fill aperture, said cap when closed denying egress from said reservoir; said valves having pressure actuated opening means, said valves under pressure allowing liquid to exit said reservoir, said valves when not under pressure denying egress from said reservoir; an outer layer enclosing said wall, said outer layer being shaped to resemble a food item.
3. The apparatus of claim 2 further comprising indicia on said outer layer.
4. (Amended) The apparatus of claim 2 further comprising a cord attached to said apparatus.
5. (Amended) The apparatus of claim 2 further comprising a noisemaker contained within said reservoir.
7. In combination:
a reservoir having a wall, said wall having a fill aperture and valves, said fill aperture having an openable cap, said valves comprising bores penetrating said wall;

a valve mechanism shaped substantially to fill said bores, said

valve mechanism being capable of alternate movement substantially perpendicular to said wall, said valve mechanism having an opening permitting liquid to flow from said reservoir during a first state of the alternate movement of said valve mechanism, said opening being blocked by said wall during a second state of the alternate movement of said valve mechanism;

return means urging said valve mechanism to said second state of the alternate movement of said valve mechanism;

said valve mechanism being movable to said first state of the alternate movement of said valve mechanism by application of pressure.

8. (Amended) The apparatus of claim 7 wherein said pressure is applied to said valve mechanism.

10. The apparatus of claim 7 further comprising a cord having attachment means, said attachment means connecting said cord to said apparatus.

11. (Amendment) The apparatus of claim 7 further comprising an outer layer attached to said wall, said outer layer being shaped to resemble a food item.

12. The apparatus of claim 11 wherein said outer layer bears indicia.

13. The apparatus of claim 7 further comprising a noisemaker contained within said reservoir.

☐ OTHER MATERIAL THAT APPELLANT CONSIDERS NECESSARY OR DESIRABLE

(use additional OTHER MATERIALS CONSIDERED NECESSARY OR DESIRABLE pages,
as required)



SIGNATURE OF PRACTITIONER

Reg. No. 42,176

Charles R. Sutton

(type or print name of practitioner)

Tel. No.: (81) 8-780-6616

14507 Sylvan St., Ste. 208

P.O. Address

Customer No.:

Van Nuys, CA 91411



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PATENT TRADEMARK OFFICE

(Appellant's Brief [9-6.2]—Final Page 20 of 20)



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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Jeffrey Lynn Chamberlain

Application No.: 09 / 922,376 Group No.: 3644

Filed: 08/03/2001

Examiner: Smith, Kimberly

For: Dog Watering Toy

Assistant Commissioner for Patents

Washington, D.C. 20231

ATTENTION: Board of Patent Appeals and Interferences

APPELLANT'S BRIEF (37 C.F.R. § 1.192)

This brief is in furtherance of the Notice of Appeal, filed in this case on Nov. 27, 2003

The fees required under § 1.17, and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate. (37 C.F.R. § 1.192(a))

NOTE: Appellant's brief is required by 37 C.F.R. § 1.192(c) to contain the following items, under appropriate headings, in the following order:

- (1) identification of the real party in interest;
- (2) identification of related appeals and interferences;
- (3) status of all the claims, pending or canceled, and identifying the claims appealed;
- (4) status of any amendment filed subsequent to final rejection;
- (5) summary of the invention;
- (6) concise statement of the issues presented for review;
- (7) statement that the claims of a group do not stand or fall together as to each ground of rejection that applies to two or more claims;
- (8) arguments of the appellant, with each issue in separate headings, with respect to each issue presented for review; and
- (9) an appendix containing a copy of the claims involved in the appeal.

The rule further sets out specific requirements for arguments against rejections based on 35 U.S.C. §§ 102, 103, 112 and other grounds. The examiner's answer to the brief will follow a corresponding format.

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. § 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

FACSIMILE

☒ deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to the

Assistant Commissioner for Patents,

Washington, D.C. 20231.

Commissioner for Patents
P.O. Box 1450, Alexandria,

Date: 1/26/04 VA22313-1450

☐ transmitted by facsimile to the Patent and Trademark Office.



Signature

Charles R. Sutton

(type or print name of person certifying)

(Appellant's Brief—First Page [9-6.2]—page 1 of 20)

Pursuant to 37 C.F.R. § 1.192(d), if a brief is filed that does not comply with the new requirements, as set forth in paragraph (c) of the rule, the appellant will be notified of the reasons for noncompliance and provided with a period of one month within which to file an amended brief. The one-month period will not be extended. If appellant does not file a brief overcoming the reasons for noncompliance within the one-month period, or files an amended brief that does not overcome all the reasons for noncompliance stated in the notification, the appeal will be dismissed.

If appellant disagrees with the examiner's holding of noncompliance, a petition under 37 C.F.R. § 1.181 may be filed. Notice of May 3, 1988 (1092 O.G. 26-35).

NOTE: 37 C.F.R. § 1.192(c) merely specifies the minimum requirements for a brief, and does not prohibit the inclusion of any other material which an appellant may consider necessary or desirable, for example, a list of references, table of contents, table of cases, etc. A brief is in complete compliance with 37 C.F.R. § 1.192(c) as long as it includes items (1) to (9) in the order set forth (with the appendix, item (9), at the end). See also Notice of March 3, 1995, 60 Fed. Reg. 14,488-14,536, at 14,500 and M.P.E.P. § 1206, 7th. ed.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 1.192(c)):

- I REAL PARTY INTEREST
- II RELATED APPEALS AND INTERFERENCES
- III STATUS OF CLAIMS
- IV STATUS OF AMENDMENTS
- V SUMMARY OF INVENTION
- VI ISSUES
- VII GROUPING OF CLAIMS
- VIII ARGUMENTS

(check each category of ARGUMENT submitted in this brief)

- ☐ ARGUMENT: VIIIA REJECTIONS UNDER 35 U.S.C. 112, FIRST PARAGRAPH
- ☐ ARGUMENT: VIIIB REJECTIONS UNDER 35 U.S.C. 112, SECOND PARAGRAPH
- ☒ ARGUMENT: VIIC REJECTIONS UNDER 35 U.S.C. 102
- ☒ ARGUMENT: VIID REJECTIONS UNDER 35 U.S.C. 103
- ☐ ARGUMENT: VIIIE REJECTIONS OTHER THAN 35 U.S.C. 102, 103 AND 112
- IX APPENDIX OF CLAIMS INVOLVED IN THE APPEAL
- ☒ OTHER MATERIALS THAT APPELLANT CONSIDERS NECESSARY OR DESIRABLE *not included.*

The final page of this brief bears the practitioner's signature.

WARNING: "Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown." 37 C.F.R. § 1.192(a).

The Board has leeway to consider arguments or authorities not included in the brief under circumstances where the failure to include them can be justified. Notice of May 3, 1988 (1092 O.G. 26-35).

I REAL PARTY IN INTEREST (37 C.F.R. § 1.192(c)(1))

NOTE: The brief shall contain "A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest." 37 C.F.R. § 1.192(c)(1). See M.P.E.P. § 1206, 7th ed.

The real party in interest in this appeal is:

- ☒ the party named in the caption of this brief.
- ☐ the following party:

II RELATED APPEALS AND INTERFERENCES

(34 C.F.R. § 1.192(c)(2))

NOTE: The brief shall contain "[a] statement identifying by number and filing date all other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal." 37 C.F.R. § 1.192(c)(2). See M.P.E.P. § 1206, 7th ed.

(complete (A) or (B), as applicable)

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal:

A ☒ there are no such appeals or interferences.

B ☐ these are as follows:

III STATUS OF CLAIMS (37 C.F.R. § 1.192(c)(3))

NOTE: The brief shall contain: "A statement of the status of all the claims, pending or cancelled, and identifying the claims appealed." 37 C.F.R. § 1.192(c)(3).

For each claim, the appellant "should state whether it is cancelled, allowed, rejected, etc. Each claim on appeal must be identified." Notice of May 3, 1988 (1092 O.G. 26-35). See M.P.E.P. § 1206, 7th ed.

The status of the claims in this application are:

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20.

B. STATUS OF ALL THE CLAIMS

(if there are no claims in a category, indicate: NONE)

1. Claims cancelled: NONE
2. Claims withdrawn from consideration but not cancelled: 6; 9, 14-20.
3. Claims pending: 1-20.
4. Claims allowed: NONE
5. Claims rejected: 1, 2, 3, 4, 5, 7, 8, 10, 11, 12, 13.

C. CLAIMS ON APPEAL

The claims on appeal are: 1, 2, 3, 4, 5, 7, 8, 10, 11, 12, 13.

IV STATUS F AMENDMENTS (37 C.F.R. § 1.192(c)(4))

NOTE: The brief shall contain "A statement of the status of any amendment filed subsequent to final rejection." 37 C.F.R. § 1.192(c)(4). "The appellant should state, insofar as understood by the appellant, the status of any amendment filed subsequent to final rejection, i.e., whether or not the amendment has been acted upon by the examiner, and if so, whether it was entered, denied entry, or entered in part." The inclusion of the status of claims (Section I) [now Section 3] and this section will advise the examiner of what the appellant considers the status of the claims and post-final rejection amendments to be, allowing any disagreements on these questions to be resolved before the appeal is taken up for decision by the Board. Notice of May 3, 1988 (1092 O.G. 26-35). See M.P.E.P. § 1206, 7th ed.

No claims have been amended subsequent to the Final Rejection. Claims 1, 2, 4, 5, 11, were amended 08/05/03 (prior to the 08/29/03 final rejection). Claims 6, 8, 9, 14, 20 were amended 09/20/02 (also prior to the 08/29/03 final rejection).

V. SUMMARY OF INVENTION (37 C.F.R. sec. 1.192(c)(5))

The invention of claims 1-5 is an apparatus to alleviate pet thirst that comprises a reservoir having a wall (Figure 2, reference character 2). It also has a fill aperture (Figure 1, reference character 3), valves (Figure 1, reference character 5), and a closeable, openable cap (Figure 1, reference character 4)(Page 5, lines 7-13). The cap allows liquid to enter (page 5, lines 7, 8). There is an outer layer enclosing the wall which is shaped to resemble a food item (Figure 1)(Page 5, lines 17-23). The invention may come equipped with indicia on the outside (Figure 4, reference character 9). The invention may come equipped with an attached cord (Figure 3, reference character 7)(Page 7, lines 16-19). The invention may come equipped with a noisemaker inside the reservoir (Page 7, lines 20-23)(Figure 6, reference character 8).

The invention of claims 7, 8, 10-13 differs from this in that the preamble is merely "In combination:" and the outer layer shaped to resemble a food item is not necessarily present, since it does not appear in the independent claim 7, but is later disclosed in the dependent claim 11. Moreover, the valves are bores in the wall (claim 7, line 3)(Figure 7, reference character 5), and there is a valve mechanism in the bore (Figure 7, reference character 11)(Page 8, lines 2, 8-11). There is a return means urging the valve mechanism closed (Page 8, lines 8-11)(Figure 8) and the valve can be opened by pressure (Page 8, lines 1-2).

VI. ISSUES (37 C.F.R. sec. 1.192(c)(6))

1. Whether claims 1, 2, 7, 8, and 11 are unpatentable under 35 U.S.C. 102 over Deshaies, US Patent 5,944,516.

2. Whether claims 3 and 12 are unpatentable under 35 U.S.C. 103 over Deshaies, US Patent 5,944,516 in view of the examiner's contention of what is known in the art.

3. Whether claims 4 and 10 are unpatentable under 35 U.S.C. 103 over Deshaies, US Patent 5,944,516 in view of Hass, US Patent 5,961,406.

4. Whether claims 5 and 13 are unpatentable under 35 U.S.C. 103 over Deshaies, US Patent 5,944,516 in view of Huettnner et al., US Patent 6,092,489.

VII. GROUPING OF CLAIMS (37 C.F.R. sec. 1.192(c)(7))

With regard to the claims rejected under 35 U.S.C. 102, to wit claims 1, 2, 7, 8, and 11, these claims do not all stand or fall together. Claims 1 and 2 are in a different group than claims 7, 8, and 11. Please refer to the argument section below for additional details.

With regard to the claims rejected under 35 U.S.C. 103, to wit claims 3, 4, 5, 10, 12, and 13, these claims do not all stand or fall together. Claims 3 and 12 are in one group. Claims 4 and 10 are in a different group. Claims 5 and 13 are in yet a different group. Please refer to the argument section below for additional details.

VIIIC. ARGUMENTS-REJECTIONS UNDER 35 U.S.C. SEC. 102

(37 C.F.R. sec. 1.192(c)(8)(iii))

Claims 1, 2, 7, 8, and 11 do not all stand or fall together. Claim 1 is actually deleted and therefore simply needs to be cancelled. Claim 2 is an independent claim having an outer layer shaped to resemble a food item. Claim 7 is an independent claim that does not have an outer layer shaped to resemble a food item. Claim 7 has the limitation that the valves comprise bores and there is a valve mechanism in the bores which is capable of substantially perpendicular movement with respect to the wall. Claim 2 does not disclose such a valve mechanism. Claims 8 and 11 depend from claim 7 but not from claim 2. Therefore, since claim 2 contains an element not found in claims 7, 8, and 11, and since claims 7, 8, and 11 contain elements and cooperation between the elements not disclosed in claim 2, claim 2 must be considered separately from claims 7, 8, and 11.

Where all the elements (or their equivalents) of the claimed invention cannot be found in one unit of prior art, there is no anticipation (Firestone v. Aluminum Co. of America, 285 F.2d 928, 127 U.S.P.Q. 407 (1960)). For prior art to anticipate under 35 U.S.C. section 102 every element of the claimed invention must be identically disclosed, either expressly or under principles of inherency, in a single reference (Corning Glass Works v. Sumitomo Electric, 9 U.S.P.Q. 2d 1962, 1965 (Fed. Cir. 1989)).

ISSUE ONE

Claim 1 is actually subject to an objection rather than a rejection. Objections are not the proper subject matter of appeals, but instead of Petitions (Rule 181). Applicant will cancel the claim if appropriate after the termination of the appeal.

Applicant has amended the phrase in claim 2 about aesthetic design to read instead that the outer layer is shaped to resemble a food item. The "Deshaies invention" (US Patent No. 5,944,516) does not contain such a structure and therefore there can be no anticipation. Since all the elements of the claimed invention are not identically disclosed in the Deshaies Patent, there can be no anticipation under 35 U.S.C. section 102 and therefore the Examiner's rejection of claim 2 is improper. The Board is respectfully requested to overrule the rejection of claim 2 based on 35 U.S.C. section 102.

With respect to the rejection of claim 7 and claim 8, Applicant respectfully disagrees with the Examiner's position on the grounds that the two valves disclosed by the Deshaies invention do not have a structure that moves in a substantially perpendicular alternate movement with respect to the wall. The Deshaies invention discloses a check valve which moves in an arcuate manner and therefore is not susceptible to operation by the pressure of canine teeth. (see Figure 2). The Deshaies invention shows valves at Figure 7 which are slits deformable under pressure and therefore move in a direction substantially parallel with the wall. They also do not contain a valve mechanism at all other than the wall edges which comprise the slits. (See column 6, lines 33-39).

With respect to the rejection of claim 11, Applicant respectfully disagrees with the Examiner's position on the grounds that the two valves disclosed by the Deshaies invention do not have a structure that moves in a substantially perpendicular alternate movement with respect to the wall. The Deshaies invention discloses a check valve which moves in an arcuate manner and therefore is not susceptible to operation by the pressure of canine teeth. (see Figure 2). The Deshaies invention shows valves at Figure 7 which are slits deformable under pressure and therefore move in a direction substantially

parallel with the wall. They also do not contain a valve mechanism at all other than the wall edges which comprise the slits. (See column 6, lines 33-39). Applicant further disagrees with the rejection of claim 11 because claim 11 discloses an outer layer shaped to resemble a food item. The Deshaies invention does not disclose such a feature at all. Instead, its surface is covered with brushes. The features in applicant's invention are not identically disclosed in the Deshaies invention. Features are absent and other features work in the opposite way to those disclosed by applicant's invention.

Since all the elements of claims 7, 8, and 11 are not identically disclosed in Deshaies invention, there is no anticipation under 35 U.S.C. section 102 and therefore the rejections are improper. The Board is respectfully requested to overturn the Examiners rejection of claims 1, 2, 7, 8, and 11 based upon 35 U.S.C. section 102.

VIIID. ARGUMENTS-REJECTIONS UNDER 35 U.S.C. SEC. 103

(37 C.F.R. sec. 1.192(c)(8)(iv))

The obviousness rejection of claims 3 and 12 are founded on the Deshaies Patent in view of the Examiner's statement of what is known in the art. The obviousness rejections of claims 4 and 10 are founded on the Deshaies Patent in view of Hass, US Patent 5,961,406. The obviousness rejections of claims 5 and 13 are founded on the Deshaies Patent in view of Huettner et al., US Patent 6,092,489. Since different combinations are being made by the Examiner to reject these claims the claims do not all stand or fall together. Claims 3 and 12 are in one set, claims 4 and 10 are in another set, and claims 5 and 13 are in a third different set, each set of which will require a different analysis of whether the combination of references is sufficient to render the invention obvious under 35 U.S.C. section 103. The sets must be considered separately.

When the alleged prior art does not specifically address the types of problems addressed by the technology of the invention, the prior art alleged is not applicable in combinations to render the invention obvious (Caster v. U.S., 9 U.S.P.Q. 2d 1753 (Cls. Ct. 1988)). Where the prior art does not appreciate the existence of the problem solved by the invention, the applicant's recognition of the problem is, in itself, strong evidence of the non-obviousness of the invention (In Re Nomiya, et al., 184 U.S.P.Q. 607, 612-613 (C.C.P.A. 1975)).

ISSUE TWO

Applicant respectfully disagrees with the Examiner's position and insists that claim 3 shows indicia that would not be visible through the brushes covering the Deshaies

invention. See Figure 1 and Figure 5 of the Deshaies invention. The Deshaies invention has a surface almost entirely covered in brushes or valves. Since this would cover or obscure any indicia on the surface, Deshaies teaches away from the invention of Jeffrey Chamberlain making Chamberlain's invention non-obvious. Applicant respectfully disagrees with the Examiner's position with respect to claim 12 in that claim 12 shows indicia that would not be visible through the brushes covering the Deshaies invention. See Figure 1 and Figure 5 of the Deshaies invention. The Deshaies invention has a surface almost entirely covered in brushes or valves. Since this would cover or obscure any indicia on the surface, Deshaies teaches away from the invention of Jeffrey Chamberlain making Chamberlain's invention non-obvious. In fact, the Deshaies Patent does not appreciate the existence of the problem solved by the invention since it is solving another problem (brushing an animal's teeth). The brushes are where the indicia would be because of this failure to appreciate the problem. That is strong evidence of the non-obviousness of the Chamberlain claims 3 and 12 according to In Re Nomiya, et al. *Supra*. Moreover, the Deshaies Patent does not specifically address the problem of how to provide a metered amount of drinking water for an animal and therefore Deshaies is not applicable in combinations to render claims 3 and 12 obvious according to Caster v. U.S. *Supra*. Finally, indicia are not known in the art to make the device more attractive to the animals, notwithstanding the Examiners unsupported statement to the contrary. Dogs and cats cannot read, and they are colorblind. The rejection of claims 3 and 12 under 35 U.S.C. section 103 is not proper and Applicant respectfully requests the Board to overturn the Examiner's rejection of those claims on that ground.

ISSUE THREE

Applicant respectfully disagrees with the Examiner's position and insists that claim 4 discloses a feature which the Deshaies invention teaches away from, and in fact states that the feature would be harmful to pets. See Column 2, lines 3-7 where the Deshaies invention teaches that dogs could tear apart and choke on large pieces of rope. Deshaies assumes, in other words that dogs would choke on the carrying strap disclosed by the Chamberlain invention. Chamberlain's use of the carrying strap is therefore non-obvious. Applicant respectfully disagrees with the Examiner's position about claim 10, and insists that claim 10 discloses a feature which the Deshaies invention teaches away from, and in fact states that the feature would be harmful to pets. See Column 2, lines 3-7 where the Deshaies invention teaches that dogs could tear apart and choke on large pieces of rope. Deshaies assumes, in other words that dogs would choke on the carrying strap disclosed by the Chamberlain invention. Chamberlain's use of the carrying strap is therefore non-obvious. The prior art does not specifically address the types of problems addressed by claims 4 and 10 herein, and in fact specifically teaches away from that technology. Deshaies cannot be used in combinations to render claims 4 and 10 obvious because of the working of Caster v. U.S. *Supra*. The combination with Hass (US Patent 5,961,406) would be inoperative because the Hass device has a rope going through the hollow portion (see Figure 3) and therefore water would be continually soaking out through the rope itself, whether the toy was being used or not. Hass does not appreciate the existence of the problem being solved by Applicant and therefore claims 4 and 10 are non-obvious according to In Re Nomiya *Supra*. The rejection of claims 4 and 10 for obviousness due to Deshaies in view of Hass is improper and the Board is respectfully

requested to overrule the Examiner's rejection of these claims under 35 U.S.C. section 103.

ISSUE FOUR

Applicant respectfully disagrees with the Examiner's position and insists that claim 5 discloses a feature which would be completely inoperable if combined with the Deshaies invention. The hollow cavity in Deshaies is affirmatively stated to be filled with a liquid of a paste-like consistency. Such a liquid would prevent a bell from ringing or a reed from sounding and therefore the Deshaies invention teaches away from the combination made by Chamberlain in the instant invention. This claim is therefore non-obvious. Applicant respectfully disagrees with the Examiner's position and insists that claim 13 discloses a feature which would be completely inoperable if combined with the Deshaies invention. The hollow cavity in Deshaies is affirmatively stated to be filled with a liquid of a paste-like consistency. Such a liquid would prevent a bell from ringing or a reed from sounding and therefore the Deshaies invention teaches away from the combination made by Chamberlain in the instant invention. This claim is therefore non-obvious. Deshaies does not specifically address the question of noisemaking in a pet toy and is therefore not applicable to render claims 5 and 13 obvious according to Caster v. U.S. Supra. Deshaies shows that it does not even appreciate the existence of the problem being solved in claims 5 and 13 herein (because of the paste) and this is strong evidence of the non-obviousness of the invention of claims 5 and 13 according to In Re Nomiya Supra. Huettner et al. (US Patent No. 6,092,489) shows tennis balls without any valves whatsoever. There is no addressing of the problem of watering a dog and therefore this patent cannot be used in combinations to render claims 5 and 13 obvious (Caster v. U.S.

Supra). The Examiner's use of Deshaies and Huettnet et al. to reject claims 5 and 13 as obvious is improper and the Board is respectfully requested to overrule the Examiners rejection of claims 5 and 13 under 35 U.S.C. section 103.

IX. APPENDIX OF CLAIMS (37 C.F.R. sec. 1.192(c)(9))

The texts of the claims involved in the appeal are:

1. (Amended)
2. (Amended) An apparatus to alleviate pet thirst comprising:
a reservoir having a wall, said wall having a fill aperture and valves; said fill aperture having a closeable openable cap, said cap when open allowing liquid to enter said reservoir through said fill aperture, said cap when closed denying egress from said reservoir; said valves having pressure actuated opening means, said valves under pressure allowing liquid to exit said reservoir, said valves when not under pressure denying egress from said reservoir; an outer layer enclosing said wall, said outer layer being shaped to resemble a food item.
3. The apparatus of claim 2 further comprising indicia on said outer layer.
4. (Amended) The apparatus of claim 2 further comprising a cord attached to said apparatus.
5. (Amended) The apparatus of claim 2 further comprising a noisemaker contained within said reservoir.
7. In combination:
a reservoir having a wall, said wall having a fill aperture and valves, said fill aperture having an openable cap, said valves comprising bores penetrating said wall;

a valve mechanism shaped substantially to fill said bores, said

valve mechanism being capable of alternate movement substantially perpendicular to said wall, said valve mechanism having an opening permitting liquid to flow from said reservoir during a first state of the alternate movement of said valve mechanism, said opening being blocked by said wall during a second state of the alternate movement of said valve mechanism;

return means urging said valve mechanism to said second state of the alternate movement of said valve mechanism;

said valve mechanism being movable to said first state of the alternate movement of said valve mechanism by application of pressure.

8. (Amended) The apparatus of claim 7 wherein said pressure is applied to said valve mechanism.

10. The apparatus of claim 7 further comprising a cord having attachment means, said attachment means connecting said cord to said apparatus.

11. (Amendment) The apparatus of claim 7 further comprising an outer layer attached to said wall, said outer layer being shaped to resemble a food item.

12. The apparatus of claim 11 wherein said outer layer bears indicia.

13. The apparatus of claim 7 further comprising a noisemaker contained within said reservoir.

☐ OTHER MATERIAL THAT APPELLANT CONSIDERS NECESSARY OR DESIRABLE

(use additional OTHER MATERIALS CONSIDERED NECESSARY OR DESIRABLE pages,
as required)


SIGNATURE OF PRACTITIONER

Reg. No. 42,176

Charles R. Sutton

(type or print name of practitioner)

Tel. No.: (81) 8-780-6616

14507 Sylvan St., Ste. 208

P.O. Address

Customer No.:

Van Nuys, CA 91411



27615

PATENT TRADEMARK OFFICE

(Appellant's Brief [9-6.2]—Final Page 20 of 20)